



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,324	01/20/2004	Brett Lickle	LKL-100	9784
66612 7590 05/13/2008 MCCARTER & ENGLISH, LLP BASIL S. KRIKELIS Renaissance Centre 405 N. King Street, 8th Floor WILMINGTON, DE 19801				
EXAMINER				
NGUYEN, TAM M				
ART UNIT		PAPER NUMBER		
3764				
MAIL DATE		DELIVERY MODE		
05/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/760,324

**Applicant(s)**

LICKLE, BRETT

**Examiner**

TAM NGUYEN

**Art Unit**

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-11, 13, 14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11, 14 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 6 is objected to because of the following informalities:

In claim 6, on line 2 is the phrase "comprising a board and only one substantially spherical balancing insert". This phrase is illogical since the transitional term "comprising" is open ended such that there can be more than one balancing insert. It is suggested that the applicant rephrase the statement as follows: --consisting of only one substantially spherical balancing insert and comprising a board...--. Claims 7-11, 13 and 14 are also objected to for being dependent on an objected base claim.

Appropriate correction is required.

Please note the following section of the MPEP regarding transitional phrases.

#### **2111.03 Transitional Phrases [R-3]**

The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term 'comprising,' the terms 'containing' and 'mixture' are open-ended."); *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). >In *Gillette Co. v. Energizer Holdings Inc.*, 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to "a safety

Art Unit: 3764

razor blade unit comprising a guard, a cap, and a group of first, second, and third blades" encompasses razors with more than three blades because the transitional phrase "comprising" in the preamble and the phrase "group of" are presumptively open-ended. "The word 'comprising' transitioning from the preamble to the body signals that the entire claim is presumptively open-ended." *Id.* In contrast, the court noted the phrase "group consisting of" is a closed term, which is often used in claim drafting to signal a "Markush group" that is by its nature closed. *Id.* The court also emphasized that reference to "first," "second," and "third" blades in the claim was not used to show a serial or numerical limitation but instead was used to distinguish or identify the various members of the group. *Id.*<

The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith."). But see *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004) (holding that a bone repair kit "consisting of" claimed chemicals was infringed by a bone repair kit including a spatula in addition to the claimed chemicals because the presence of the spatula was unrelated to the claimed invention). A claim which depends from a claim which "consists of" the recited elements or steps cannot add an element or step. When the phrase "consists of" appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986). >See also *In re Crish*, 393 F.3d 1253, 73 USPQ2d 1364 (Fed. Cir. 2004) (The claims at issue "related to purified DNA molecules having promoter activity for the human involucrin gene (hINV)." *Id.*, 73 USPQ2d at 1365. In determining the scope of applicant's claims directed to "a purified oligonucleotide comprising at least a portion of the nucleotide sequence of SEQ ID NO:1 wherein said portion consists of the nucleotide sequence from ... to 2473 of SEQ ID NO:1, and wherein said portion of the nucleotide sequence of SEQ ID NO:1 has promoter activity," the court stated that the use of "consists" in the body of the claims did not limit the open-ended "comprising" language in the claims (emphases added). *Id.* at 1257, 73 USPQ2d at 1367. The court held that the claimed promoter sequence designated as SEQ ID NO:1 was obtained by sequencing the same prior art plasmid and was therefore anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides. *Id.* at 1256 and 1259, 73 USPQ2d at 1366 and 1369. The court affirmed the Board's interpretation that the transition phrase "consists" did not limit the claims to only the recited numbered nucleotide sequences of SEQ ID NO:1 and that "the transition language 'comprising' allowed the claims to cover the entire involucrin gene plus other portions of the plasmid, as long as the gene contained the specific portions of SEQ ID NO:1 recited by the claim[s]" *Id.* at 1256, 73 USPQ2d at 1366.<

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 7, 9 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Armer, Jr. (4,191,371).

2. As to claim 6, 7, 9 and 16, Armer, Jr. discloses a balance training device and inherently a method for exercising as substantially claimed, the device comprising a board (14) and a single substantially spherical balancing insert (12) wherein the board comprises an upper surface (24) and a lower surface (22) having a circularly shaped concave region extending into the board below the upper surface from the lower surface toward the upper surface with the concave region adapted to receive the balance insert to allow the board to ride over the insert such that the upper surface is adapted to permit a user to distribute his weight to any position on the upper surface and the concave region encompasses an area: larger than an area defined by the circumference of the insert and between 15%-95% of the lower surface wherein the apex of the concave region is disposed between the lower surface and the upper surface and the board has a general surfboard/round or circular shape (see Figs. 1-4, Col. 2, lines 17-21 & Amended Fig. 2 shown in the last Office Action dated October 29, 2007). Note, the prior art, such as Sorenson (37,16,88) discloses a surfboard having a round or circular shape.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Romero (5,897,474).

3. As to claim 11, Romero discloses a balance training device comprising a board (44), one spherical balancing insert (14) having a circumference and a securing device (32,18,20) adapted to secure the balancing insert to the board wherein the board comprises an upper surface and a lower surface, the lower surface comprises a concave region (15,16) extending into the board from the lower surface toward the upper surface, the apex of the concave region is disposed between the lower surface and the upper surface, the concave region is adapted to receive the balance insert, the board rides over the balancing insert, the concave region encompasses an area greater than an area defined by the circumference of the balance insert, the securing device extends through the board from the lower surface to the upper surface and the board has a general snow board shape (Figs. 1-3 & Col. 7, lines 9-14). Note, the area defined by the circumference of the balance insert is broadly interpreted as the area covered by a circumferential line around the insert and this area is a function of the thickness of that line. The examiner contends that the concave region/area defined by the bevel edge (15) of opening (16) is indeed greater than the area of the circumferential line assuming the line has a minimal thickness.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3764

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armer, Jr. 371 in view of Sasser, Jr. (3,488,049).

4. As to claims 8 and 10, Armer discloses a balance trainer as substantially claimed (see discussion of claim 6). Armer does not disclose that board includes a concave region with a substantially oval or rectangular shape. Sasser discloses a similar trainer having a board (20) having a concave region (30) with a substantially oval/oblong or rectangular shape (see Figs. 1, 2, 4 & 6 and Col. 1, lines 64-69). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the shape of Armer's concave region into any of an array of shapes including that of an oval or rectangle as long as the insert is still able to rotate in all directions and the shape provides an adequate stop to prevent the platform from disengaging from the spherical fulcrum insert. A change in the shape of a prior art device is a design consideration within the skill on the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Claims 6, 14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over England '768 in view of Sasser, Jr. '049.

5. See paragraphs 6 and 7 of the last Office Action dated October 29, 2007. Note, England's trainer is circular and the prior art discloses surfboards that are circular.

***Allowable Subject Matter***

6. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments with respect to claims 6, 7, 9, 11 and 16 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed February 6, 2008 regarding claims 6, 8, 10, 14 and 16-19 have been fully considered but they are not persuasive. As to claims 8 and 10, Applicant argues that the present invention is not rendered obvious by Armer in view of Sasser. In particular, Applicant argues that the Armer and Sasser references are directed to more simple balancing apparatus wherein a user's feet are "centrally located" or located with precision on foot pads thereby suggesting that the combination is different from the invention which develops user balancing skills that include the ability to balance while moving their feet and substantially shifting their center of weight over the board to simulate real life use. The examiner asserts that this argument is not persuasive since the combination of Armer in view of Sasser, despite the disclosure or suggestion of specific placement of a user's feet, still allows for a user to shift his center of weight over the board to simulate real life use. Note, a user does not have to move his feet to shift his center of weight but merely has to lean in any of a plurality of directions to shift said weight. Furthermore, Applicant tries to differentiate the invention from the prior art by stating that Armer and Sasser do not disclose an apparatus that allows for balancing skills that include "moving their feet" apparently along the board yet the applicant has no support for this in the specification or claims. As to claims 6, 14, and 16-19, Applicant argues that the present invention is not rendered obvious by England in view of Sasser. Again, the combination allows for a user to shift his center



Art Unit: 3764

of weight over the board to simulate real life use and the purported limitation of an apparatus that allows for balancing skills that include “moving their feet” is baseless since that limitation or idea is not present in the specification or claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sorenson '880 discloses a circular surfboard.

De La Cierva, Jr. '957 discloses a circular surfboard.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAM NGUYEN whose telephone number is (571)272-4979. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on 571-272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 11, 2008

/Tam Nguyen/  
Examiner, Art Unit 3764

/LoAn H. Thanh/  
Supervisory Patent Examiner, Art Unit 3764